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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,223	09/21/2001	Icon C. Chen	EQUUS-060A	4084

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STETINA BRUNDA GARRED & BRUCKER  
75 ENTERPRISE, SUITE 250  
ALISO VIEJO, CA 92656

EXAMINER

NGUYEN, TAN QUANG

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/961,223

Applicant(s)

CHEN, IEON C.

Examiner

TAN Q NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAIL ACTION

### *Notice to Applicant(s)*

1. This office action is responsive to the amendment filed on 01/08/2003. As per request, claims 1, 4, 13 and 22 have been amended. Claims 26-28 have been added. Thus, claims 1-28 are still pending.

### *Claim Rejections - 35 USC § ~~103~~ 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "wireless code reader" that was added to the claims 1 and 13 is not supported by the original disclosure in the specification. Appropriated correction is required. Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 3-13, 16-22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubozono et al. (5,506,772) in view of Chou et al. (6,330,499), Gordon (4,207,611) and Fera (6,263,265).

7. With respect to claims 1, 2, 14, 15, 23 and 24, Kubozono et al. disclose an apparatus and method of diagnosing a vehicle via a remote computer which includes the steps of connecting a portable tester to the onboard computer (see figure 1), communicating between the tester with the onboard computer to see if there is a malfunction signal of the various control systems (see column 2, lines 54-67), communicating between the tester and a personal computer regarding to the malfunction signal (see figure 1 and column 3, lines 4-15), communicating between the personal computer and a remote computer regarding to the malfunction status (see figure 1 and the related text).

8. Kubozono et al. do not explicitly disclose that the diagnostic trouble codes. However, such codes are well known at the time the invention was made and shown in at least the Chou et al. reference in at least figure 3 and column 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made realize that the "trouble codes" as taught in the Chou et al. can be used in place of the "abnormal signal" as mention in the Kubozono et al. in order to refer to the exact problem of the various vehicle systems.

9. Kubozono et al. and Chou et al. disclose the claimed invention as discussed above except for the color visual indicators at the tester, each color indicator representing a respective status. However, Gordon does suggest a portable tester which includes the indicators, "ok", "low" or "high" LEDs, each indicates the status of the various vehicle systems (see figures 1, 7 and the related text). Furthermore, it is obvious to one of ordinary skill in the art at the time the invention the color codes are well know used to indicate the status of the unit. For example in the Fera reference, green for a properly functioning unit, yellow for an abnormally in one of its operating parameters, and red for a critical fault (see column 3, lines 54-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Gordon and Fera into the system of Kubozono et al. and Chou et al. in order to modify the tester with the visual color indicators for not only identify the fault unit but also give the indication of how critical the fault unit is.

10. With respect to claims 3-6, Chou et al. do suggest the use of computer network including the Internet and the web site. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Internet as means of communicating between the personal computer and the remote computer in order to improve the communication network in the Kubozono et al. reference.

11. With respect to claims 7-13-25, the limitations of these claims have been noted in the rejection above and the cited references. It also too obvious that the portable unit can be in the read mode only when retrieving the trouble codes from the on-board computer. They are therefore considered rejected as set forth above.

12. With respect to claims 26-28, it would have been obvious to one of ordinary skill in the art the when the trouble codes are transferred to the portable unit, the indicators on the portable unit are independent of any communication with the personal computer since it does not need the personal computer just yet.

#### ***Remarks***

13. Applicant's arguments filed on 01/08/2003 have been fully considered but they are not deemed to be persuasive.

14. In the amendment, applicants essentially argue that the references cited are used for large scale computer system; "may be hard wired to facilitated bi-directional communication with the service center"; "such systems are not practical for backyard mechanics who wish to service their own inexpensive vehicle". Such arguments have nothing to do with the claimed invention. Upon examination of the claims, the references cited clearly cover the subject matter AS CLAIMED by the applicants in the above rejections. Therefore, the rejection under 35 U.S.C. § 103 is considered to be proper.

15. Applicant further stated that "the present invention provides a code reader that is neither wired to the personal computer/technician station, nor an electrical communication therewith". Examiner disagreed with the applicant since the code reader DOES connects with the personal computer via computer connector interface

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(see figure 2, item 38). Furthermore, claims 1 and 13 have been amended to include the feature that the code reader is a wireless unit. Examiner also disagreed as to the code reader is not a wireless unit since it connects to the on-board computer via the on-board computer connection interface 18 and cable connector 22 as shown in figure 1. Application is suggested to correct such inappropriate amending claims.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Tan Nguyen, whose telephone number is (703) 305-9755. The examiner can normally be reached on Monday-Thursday from 5:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, can be reached on (703) 308-3873.

Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks  
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or faxed to:

(703) 305-7687, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park V, 2451  
Crystal Drive, Arlington, VA., Seventh Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be  
directed to the Group receptionist whose telephone number is (703) 308-1113.

/tqn  
March 8, 2003

  
**TAN Q. NGUYEN**  
*Primary Examiner*  
*Art Unit 3661*